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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,080	04/15/2004	Douglas F. Boltzman	014208.1647 (50-03-019)	7168
35005 7590 08/08/2008 BAKER BOTTS L.L.P. 2001 ROSS AVENUE, 6TH FLOOR DALLAS, TX 75201-2980				
EXAMINER PARKER, BRANDI P				
ART UNIT 3623		PAPER NUMBER		
NOTIFICATION DATE 08/08/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail2@bakerbotts.com

PTOmail4@bakerbotts.com

### Office Action Summary

**Application No.**

10/825,080

**Applicant(s)**

BOLZMAN ET AL.

**Examiner**

BRANDI P. PARKER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. Claims 1-38 are pending in this Office Action.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-16 and 28-38 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

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5. Claim 1 is directed to identifying and monitoring best practices of an enterprise. As the claims are not sufficiently tied to an apparatus, such as a computer, the claim is therefore rejected under 35 U.S.C. 101.

6. As to claim 28, software per se consists of non patentable subject matter. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. MPEP 2106.01 I.

7. Claims 2-16 and 29 -38 are rejected for being dependent upon rejected claims 1 and 28 respectively.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-8, 10, 13, 15, 17-22, 24, 26, 28-33 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Balz et al (US 2003/0018519).

10. With respect to claims 1, 3, 14-15, 17, 26, 28 and 37, Balz teaches a process for identifying and monitoring one or more best practices of an enterprise, comprising:

- a. defining a set of criteria for determining whether each of a plurality of practices of the enterprise qualify as a best practice of the enterprise (paragraph 0043, regarding assessment criteria for process levels);
- b. receiving a practice profile of a particular practice of the enterprise, the practice profile comprising information associated with the particular practice and relating to one or more of the criteria (paragraph 0040, regarding defined business process and detailed description); and
- c. performing a maturity assessment process to determine, based on a comparison between the practice profile for the particular practice and the set of criteria, whether the particular practice qualifies as a best practice of the enterprise and, if the particular practice so qualifies, assigning a best practice maturity level to the particular practice, the best practice maturity level defining to what degree the particular practice qualifies as a best practice of the enterprise (paragraph 0043 regarding assessment scheme for whether information regarding a particular process fulfills criteria and categorized into a maturity level; paragraph 0050, regarding categories characterizing different process maturity levels).

11. As to claim 2, Balz teaches the process of claim 1, wherein the practice profile comprises a template populated with information specific to the particular practice, the template comprising a plurality of fields for entering information specific to the particular practice and relating to the criteria (paragraph 0043 regarding assessment scheme for whether information regarding a particular process fulfills criteria and categorized into a maturity level).

12. Regarding claims 4, 8, 18, 22, 29 and 33, Balz teaches the process of claim 1, wherein the maturity assessment process comprises, for one or more criteria in the set of criteria, assigning a score to the particular practice based at least on the information in the practice profile of the particular practice relating to the one or more criteria, the score indicating to what degree the particular practice meets the criteria (paragraph 0043, regarding subscores for particular category).

13. With respect to claims 5, 19, 21, 30 and 32, Balz teaches the process of the claim 4, wherein:

- d. one or more criteria in the set of criteria comprise, for each best practice maturity level, a predefined score for determining whether the particular practice satisfies the criterion for the best practice maturity level (paragraph 0043, regarding subscores for particular category);

e. each best practice maturity level is associated with a predefined total score reflecting a sum of the predefined scores for each criterion in the set of criteria for the best practice maturity level; and the maturity assessment process comprises:

i. summing the scores of the particular practice for each criterion in the set of criteria to determine a total score; and determining whether to assign the particular practice a particular best practice maturity level by comparing the total score for the particular practice to the predefined total score for the particular best practice maturity level. (paragraph 0043, regarding a summing the subscores to reveal a score dependent upon degree of fulfillment of a respective criterion)

14. As to claims 6, 20 and 31, Balz teaches the process of the claim 5, comprising, for each best practice maturity level: defining for each best practice maturity level a minimum predefined total score required for the particular practice to be assigned to the particular best practice maturity level and a maximum predefined total score required for the particular practice to be assigned to the particular best practice maturity level; determining whether to assign the particular practice to a particular best practice maturity level by determining whether the total score for the particular practice falls on or between the maximum and minimum predefined total scores for the particular best

practice maturity level (paragraphs 0061-0069, regarding determining whether a minimum criteria are achieved and calculating a final score).

15. With respect to claim 10, Balz teaches the process of claim 1, wherein the maturity assessment process is performed automatically by a computer system comprising one or more processors and one or more memory units (paragraph 0013, regarding maturity assessment process is accomplished in an automated way).

16. As to claim 13, Balz teaches the process of claim 12, wherein the review of the existing best practice is performed annually consist of nonfunctional descriptive material that does not effect the functionality of the disclosed method and process maturity assessment as provided in Balz. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. MPEP 2106.01.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 11, 24 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balz et al (US 2003/0018519).

19. Regarding claims 11, 24 and 35, Balz teaches the process of claim 1 and establishing process maturity levels (paragraph 0050). Balz does not directly teach wherein the best practice maturity levels comprise one or more of: an associate best practice maturity level; a standard best practice maturity level; and a mastery best practice maturity level. However, assignment of specified titles to the maturity levels consists of nonfunctional descriptive material. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. MPEP 2106.01. Therefore, it would have been obvious to one with ordinary skill in the art to assign specific titles of associate best practice maturity level, standard best practice maturity level and mastery best practice maturity level to the maturity levels provided in Balz.

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20. Claims 9, 12, 16, 23, 25, 27, 34, 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balz et al (US 2003/0018519) in view of Sandoval et al (US 2003/0004766).

21. With respect to claims 9, 23 and 34 Balz teaches the process of claim 1 regarding a maturity assessment process. Balz does not explicitly teach having an analysis, approval or scheduling phase. Sandoval teaches wherein performing the maturity assessment process comprises one or more of the following: an analysis phase for determining the best practice maturity level to assign to the particular practice (paragraph 0040, regarding Phase II); an approval phase for approving the best practice maturity level assigned to the particular practice in the analysis phase (paragraph 0042, regarding Phase IV; and a scheduling phase for integrating the particular practice with other best practices of the enterprise (paragraph 0044, regarding Phase VI).

It would have been obvious to one of ordinary skill in the art to include the maturity assessment system of Balz with the ability to analyze, approve and schedule the implementation of the best practice as taught by Sandoval since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

22. As to claims 16, 27 and 38, Balz teaches the process of claim 1. Balz does not explicitly teach reviewing and refining the maturity assessment criteria process. Sandoval teaches reviewing the set of criteria to determine if the set of criteria reflect current views of the enterprise for determining best practices of the enterprise; and if the set of criteria are determined to not reflect current views of the enterprise for determining best practices of the enterprise, refining the set of criteria to reflect current views of the enterprise for determining best practices of the enterprise (paragraph 0033, regarding the best practice supervisor conducting periodic review of the best practices and reconciling differences).

It would have been obvious to one of ordinary skill in the art to include the maturity assessment system of Balz with the ability review and refine the best practice as taught by Sandoval since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

23. Regarding claims 12, 25 and 36, Balz in view of Sandoval teaches the process of claim 1, wherein: the particular practice comprises an existing best practice of the enterprise; and the maturity assessment process comprises a review of the existing best practice to determine if the existing best practice still qualifies as a best practice of

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the enterprise and, if the existing best practice so qualifies (paragraph 0033, regarding the best practice supervisor conducting periodic review of the best practices and reconciling differences) Balz in view of Sandoval does not directly teach revising the maturity levels when required. However because of the close association and dependencies between the maturity assessment and the maturity levels, it would be obvious to one with ordinary skill in the art to modify or assign new maturity levels upon supervisory review.

### ***Conclusion***

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDI P. PARKER whose telephone number is (571) 272-9796. The examiner can normally be reached on Mon-Thurs. 8-5pm.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRANDI P PARKER/  
Examiner, Art Unit 3623

/Andre Boyce/  
Primary Examiner, Art Unit 3623